

REMARKS

Applicant files these remarks in response to the Office Action of November 17, 2006. In the Office Action, claims 27-46 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Meyer* U.S. Patent No. 4,936,460 (“*Meyer*”) in view of *Cope* et al. U.S. Patent No. 3,716,961 (“*Cope*”).

Claims 27-46 continue to be presented for examination in view of the following remarks. Of these, claims 27, 38, and 42 are independent.

I. The Office Action simply fails to address the limitations of the claims of the present application and, therefore, Applicant is unable to respond to the Office Action in its present form.

The legal concept of *prima facie* obviousness is a procedural tool of examination that allocates the burden between the respective parties of going forward with the production of evidence in each step of the examination process. See *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971); *In re Tiffin*, 443 F.2d 394, 170 USPQ 88 (CCPA 1971), *amended*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968).

Initially, the Examiner bears the burden of factually supporting any *prima facie* case of obviousness. If the Examiner does not present a *prima facie* case of obviousness, then the Applicant is under no obligation to submit counter evidence or arguments.

To establish a *prima facie* case of obviousness, an Examiner must show that the prior art reference (or references when combined) teach or suggest all of the limitations of each claim that is rejected under §103(a). *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As such, the Examiner has the initial burden of providing some suggestion of the desirability of doing what the inventor has done. Consequently, the examiner must exhibit some understanding of what the inventor has done, i.e., what the claimed invention is. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been

obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

In the Office Action, the Examiner has simply failed to meet the basic criteria for establishing a *prima facie* case of obviousness because the Examiner has failed to address the claim limitations in the present application. Instead, it appears that the substance of the Office Action was “cut and paste” from an Office Action prepared by the Examiner in a related—but different—application of the present inventor. *As such, the Office Action addresses claim limitations not found in the present application and completely fails to address other claim limitations that are found in the present application.*

More specifically, the Examiner asserts in the Office Action that “Meyer teaches a method of packaging an individually packaged toy, vacuum-packed with an interior space of a substantially flexible, substantially air impermeable material”; that “the compressible article is capable of fitting into the pocket of an article of clothing as no specific dimensions are recited and the limitation of fitting into a pocket is relative to the size of the pocket”; and that “Meyer further teaches this method of packaging helps to eliminate soiling from handling.”

Significantly, none of the claims of the present application explicitly recite anything about a substantially air impermeable material, and it is uncertain whether the Examiner is interpreting the claims as implicitly requiring an air impermeable material. Moreover, there is no recitation of a limitation of fitting anything into a pocket of an article of clothing in any of the claims of the present application, and none of the claims of the present application recite anything about protecting an item from soiling due to handling.

In stark contrast, the claims recite methods of compressing a single diaper—the compression occurring without rolling or folding, and thereafter retaining the single diaper in the compressed condition. None of these claim limitations, for example, are addressed by the Examiner.

Because of this clear deficiency in the rejections of the Office Action, Applicant is unable to formulate a response to the §103(a) rejections on the merits. Indeed, to do so would require the Applicant to speculate as to the grounds of such rejections. Rather than trying to imagine what a rejection of the present claims may be and respond to such hypothetical rejection, Applicant respectfully requests that the claims of the present application be specifically

considered in view of the references of record and that another Office Action be issued if warranted after such review and consideration.

II. Provisional Double Patenting Rejection Acknowledgement

Applicant acknowledges the provisional double patenting rejection in the Office Action of November 16, 2006 based on copending application serial no. 11/421,758. While Applicant appreciates the Examiner's bringing such provisional rejection to Applicant's attention, Applicant elects not to address such provisional rejection at this time. Rule 111(b) requires that an applicant reply "to every ground of *objection and rejection* in [an] Office action" in order to be responsive to the Office action. The patent statute requires no such response to a provisional rejection. Accordingly, Applicant will address a double patenting rejection if the provisional status of such rejection is removed. Based on the requirements of the patent statute, Applicant believes that no further response to a provisional rejection is required or appropriate at this time.

III. Conclusion

In order to facilitate prosecution, it is respectfully requested that the Examiner contact the undersigned if any further action is deemed necessary by the Examiner in order to gain allowance of the present application, and if such further action may be accomplished through an Examiner's amendment or otherwise.

Respectfully submitted,
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